

In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897

REMARKS

The Office action has been carefully considered. The Office action rejected claims 1-8, 10-25, 27-39, and 43-47 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,347,398 to Parthasarathy et al. ("Parthasarathy"). Further, the Office action rejected claims 9, 26, and 40-42 under 35 U.S.C. § 103(a) as being unpatentable over Parthasarathy of U.S. Patent No. 6,230,171 to Pacifici et al. ("Pacifici"). Further yet, the Office action rejected claims 1-29 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully disagree.

By present amendment, claims 1, 17, 30, and 41-42 have been amended for clarification and not in view of the prior art. Claims 9, 26, and 40 are cancelled. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of the claims and not for reasons related to patentability. Reconsideration is respectfully requested.

Applicants thank the Examiner for the interview held (by telephone) on December 1, 2005. During the interview, the Examiner and applicants' attorney discussed the claims with respect to the prior art. The essence of applicants' position is incorporated in the remarks below.

Prior to discussing reasons why applicants believe that the claims in this application are clearly allowable in view of the teachings of the cited and applied references, a brief description of the present invention is presented.

In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897

The present invention is directed, generally, towards behaviors of elements in a document, in which an encapsulated component (e.g., object), external to the document, may be invoked to change the behavior (e.g., effects such as style, behavior, and/or display) of the associated element in the document. That is, the current content (elements) of the document may be modified by effects (behaviors). The associations between elements and external behavior components may be maintained in cascading style sheets, inline with the elements, and/or in various formats. When the document is provided to a renderer and the renderer parses the element in the document, the renderer may access the associated external component to modify a behavior of the page image, by running code such as script-based code.

Further, each behavior component may be external to the document and its content. As a result, for example, a library of consistent, reusable behaviors may be defined and made available for use in designing and authoring many different web pages with different content. Similar to a library of functions, the same behavior component may be invoked multiple times in multiple instances as needed from two or more different documents and may be interfaced with elements from different documents consistently, without requiring customization and so forth. Thus, not only may a single behavior be shared among elements of a document, but a behavior component may also be reused multiple times across other documents.

Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897

Rejections under §101

The Office action rejected claims 1-29 as being directed to non-statutory subject matter. Applicants respectfully disagree and submit that the claims are directed toward a method and system capable of being carried out in a computer, e.g., a computer-implemented method or computer system. MPEP § 2106(IV)(B)(1) specifically states that "a claimed computer readable medium encoded with a data structure *defines* (emphasis added) structural and functional interrelationships between the data structure and the medium which permit the data structure's functionality to be realized, and is thus statutory." In contrast, MPEP § 2106(IV)(B)(1a) goes on to state further "[d]ata structures *not claimed as embodied in computer-readable media* (emphasis added) are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

Claims 1 and 17 recite a computer-readable medium and a computer-implemented method, respectively, each having computer-executable instructions. The computer-executable instructions comprise physical steps that may be carried out in a computing environment. Even if these recitations are considered software, the execution of the method still imparts functionality to the computer-implemented method. When functional descriptive material is recorded on some computer-readable medium, e.g. a computer-implemented method, it becomes structurally and functionally interrelated to the medium and will be statutory since use of technology permits the function of the descriptive material to be realized. See, for example, *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir.

In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897

1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim).

Notwithstanding, claims 1 and 17 have been amended to recite a tangible computer-readable medium and a computer-implemented method, respectively. This remains consistent with the specification as a tangible computer-readable medium and computer-implemented method may still comprise a modulated data signal such as a carrier wave or other transport mechanism and includes any information delivery media such as a computer memory which receives such a carrier wave or modulated signal. Applicants submit that claims 1-29 are statutory and respectfully request that the rejection under §101 be withdrawn.

Rejections under §102

Turning to the anticipation rejections, amended claim 1 recites a tangible computer-readable medium having computer-executable instructions, comprising, receiving a document having an element thereon, the document including information associating the element with an external component that is encapsulated and external to the document such that multiple instances of the external component may be used with a plurality of different documents including the document having the element thereon and wherein the information associating the element with the external component is maintained in a cascading style sheet, rendering a page image corresponding to at least part of the document, the page

**In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897**

image including a representation of the element, and accessing the external component for determining a behavior of the representation of the element rendered on the page image.

The Office action rejected claim 1 as being anticipated by Parthasarathy. The Office action contends that Parthasarathy teaches the recitations of claim 1 and subsequently refers to the rejection of claim 17 for the specific references to Parthasarathy. More specifically, the Office action contends that Parthasarathy teaches encapsulating code in an external component for affecting the behavior of elements including elements of different documents. Column 6, lines 24-43 of Parthasarathy is referenced. Further, the Office action contends that Parthasarathy teaches inserting an element into a document and providing the document to a renderer. Column 1, line 60 to column 2, line 2 of Parthasarathy is referenced. Still further, the Office action contends that Parthasarathy teaches rendering a page image corresponding to at least part of the document, the page image including a representation of the element, and accessing the external component for determining a behavior of the representation of the element rendered on the page image. Column 5, line 35, and column 8, line 24 of Parthasarathy are referenced. Applicants respectfully disagree.

Notwithstanding applicants' disagreement, claim 1 has been amended to include the recitation of claim 9 and claim 9 has been cancelled. The Office action concedes that Parthasarathy does not teach the recitation of former claim 9 wherein the information associating the element with the external component is maintained in a cascading style sheet. Given this concession, the only possible

**In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897**

rejection based on Parthasarathy that could be made would be a §103(a) obviousness rejection. Pursuant to this, applicants submit that Parthasarathy may be removed from consideration as this reference qualifies as prior art only under §102(e) and may not be used to preclude patentability on obviousness grounds, because Parthasarathy, at the time the present claimed invention was made, was subject to an obligation of assignment to the same entity. A statement to establish common ownership of both the present invention and the Parthasarathy reference is attached below.

For at least these reasons, applicants submit that claim 1 is patentable over Parthasarathy whether considered alone or in any permissible combination with any prior art of record.

Applicants respectfully submit that dependent claims 2-8 and 10-16, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 1 and consequently includes the recitations of independent claim 1. As discussed above, Parthasarathy does not teach the recitations of claim 1 as amended. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

Turning to the next independent claim, amended claim 17 recites a computer-implemented method of providing dynamic effects to an HTML document, comprising, encapsulating code in an external component that may affect a behavior of one or more elements, including elements of different documents, inserting an element into a document, attaching a reference in the document to associate the element with an instance of the external component,

**In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897**

such that another instance of the element may be referenced by a different document wherein the reference associating the element with the external component is maintained in a cascading style sheet, and providing the document to a renderer.

The Office action rejected claim 17 as being unpatentable over Parthasarathy. More specifically, the Office action contends that Parthasarathy teaches encapsulating code in an external component for affecting the behavior of elements including elements of different documents. Column 6, lines 24-43 of Parthasarathy is referenced. Further, the Office action contends that Parthasarathy teaches inserting an element into a document and providing the document to a renderer. Column 1, line 60 to column 2, line 2 of Parthasarathy is referenced. Further yet, the Office action contends that Parthasarathy teaches attaching a reference in the document to associate the element with an instance of the external component, such that another instance of the element may be referenced by a different document. Column 9, beginning at line 63 of Parthasarathy is referenced. Finally, the Office action contends that Parthasarathy teaches providing the document to a renderer. Column 7, lines 27-36 of Parthasarathy is referenced. Applicants respectfully disagree.

Notwithstanding the applicants' disagreement, claim 17 has been amended to include the recitation of claim 26 and claim 26 has been cancelled. The Office action concedes that Parthasarathy does not teach the recitation of former claim 26 wherein the information associating the element with the external component is maintained in a cascading style sheet. Given this concession, the only possible

In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897

rejection based on Parthasarathy that could be made would be a §103(a) obviousness rejection. Pursuant to this, applicants submit that Parthasarathy may be removed from consideration as this reference qualifies as prior art only under §102(e) and may not be used to preclude patentability on obviousness grounds, because Parthasarathy, at the time the present claimed invention was made, was subject to an obligation of assignment to the same entity. A statement to establish common ownership of both the present invention and the Parthasarathy reference is attached below.

For at least these reasons, applicants submit that claim 17 is patentable over Parthasarathy whether considered alone or in any permissible combination at law.

Applicants respectfully submit that dependent claims 18-25 and 27-29, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 17 and consequently includes the recitations of independent claim 17. As discussed above, Parthasarathy, does not teach the recitations of claim 17 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 17 noted above, each of these dependent claims includes additional patentable elements.

Turning to the last independent claim, amended claim 30 recites in a computer system, a system for rendering page images on a display, comprising an external component encapsulating code for modifying a behavior of one or more elements, the external component operable to be instantiated multiple times and operable to modify elements in a plurality of different documents and wherein the

**In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897**

information associating the element with the external component is maintained in a cascading style sheet, and a renderer connected to the display for rendering page images, the renderer receiving a document having an element specified therein and information associating the element with the external component, the renderer rendering a page image corresponding to the document and accessing the external component for modifying the page image..

The Office action rejected claim 30 as being unpatentable over Parthasarathy. The Office action contends that Parthasarathy teaches the recitations of claim 30 and subsequently refers to the rejection of claims 1 and 17 for the specific cites to Parthasarathy. Applicants respectfully disagree.

Notwithstanding the applicants' disagreement, claim 30 has been amended to include the recitation of claim 40 and claim 40 has been cancelled. The Office action concedes that Parthasarathy does not teach the recitations of former claim 40 wherein the information associating the element with the external component is maintained in a cascading style sheet. Given this concession, the only possible rejection based on Parthasarathy that could be made would be a §103(a) obviousness rejection. Pursuant to this, applicants submit that Parthasarathy may be removed from consideration as this reference qualifies as prior art only under §102(e) and may not be used to preclude patentability on obviousness grounds, because Parthasarathy, at the time the present claimed invention was made, was subject to an obligation of assignment to the same entity. A statement to establish common ownership of both the present invention and the Parthasarathy reference is attached below.

In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897

Applicants respectfully submit that dependent claims 31-39 and 43-47, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 30 and consequently includes the recitations of independent claim 30. As discussed above, Parthasarathy, whether considered alone or in any permissible combination at law, fails to teach or suggest the recitations of claim 30 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 30 noted above, each of these dependent claims includes additional patentable elements.

Rejections under §103

The Office action rejected claims 9, 26, and 40-42 as unpatentable over Parthasarathy in view of Pacifici. Applicants respectfully disagree.

Notwithstanding, claims 9, 26, and 40 have been cancelled to expedite allowance, and not in view of the prior art. Claims 41 and 42 have been amended to depend from claim 30 instead of canceled claim 40; (again, the amendments were not in view of the prior art). Applicants submit that while the combination of Parthasarathy and Pacifici is improper as a matter of law, the point is moot, as Parthasarathy cannot be used to support a §103(a) rejection because Parthasarathy, at the time the present claimed invention was made, was subject to an obligation of assignment to the same entity. A statement to establish common ownership of both the present invention and the Parthasarathy reference is attached below.

For at least these reasons, applicants submit that all the claims are patentable over the prior art of record. Reconsideration and withdrawal of the

**In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897**

**rejections in the Office action is respectfully requested and early allowance of this
application is earnestly solicited.**

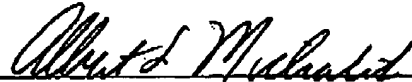
In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-8, 10-25, 27-39 and 41-47 are patentable over the prior art of record, and that the application is in good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,



Albert S. Michalik, Reg. No. 37,395
Attorney for Applicants
Law Offices of Albert S. Michalik, PLLC
704 - 228th Avenue NE, Suite 193
Sammamish, WA 98074
(425) 836-3030
(425) 836-8957 (facsimile)


In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897

RECEIVED
CENTRAL FAX CENTER
DEC 21 2005

STATEMENT TO ESTABLISH COMMON OWNERSHIP

(Regarding U.S. Patent No. 6,347,398)

Applicants, through the attorney of record, state that the present application and each of the above-identified references were, at the time the invention was made, owned by, or subject to an obligation of assignment to the same entity.



Albert S. Michalik, Reg. No. 37,395
Attorney for Applicants
Law Offices of Albert S. Michalik, PLLC
704 - 228th Avenue NE, Suite 193
Sammamish, WA 98074
(425) 836-3030
(425) 836-8957 (facsimile)

In re Application of RAMAKRISHNA et al.
Serial No. 09/316,897

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Response, along with transmittal, Statement to Establish Common Ownership, and facsimile cover sheet, are being transmitted by facsimile to the United States Patent and Trademark Office in accordance with 37 C.F.R. 1.6(d) on the date shown below:

Date: December 21, 2005



Albert S. Michalik

1890 Amendment After second RCE